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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,034	11/07/2001	Kathryn A. Bohrer	YOR920010749US1 (8728-853)	1643
46069 7590 02/04/2008 F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			EXAMINER HAMZA, FARUK	
			ART UNIT 2155	PAPER NUMBER
			MAIL DATE 02/04/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/046,034

Applicant(s)

BOHRER ET AL.

Examiner

Faruk Hamza

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is responsive to the amendment filed on December 07, 2007. Claims 1, 2, 4-13, 17-20, 22-31, 34-35 and 37 are amended. Claims 1-37 are pending.
2. The applicant should always use the period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols [®], where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Proper antecedent basis is required for newly added limitation "the requester privacy statement describes how each of the requested data-subject data will be used by the requester"

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
- Applicant's specification failed to provide sufficient description for the newly added limitation "the requester privacy statement describes how each of the requested data-subject data will be used by the requester".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear and indefinite to the examiner what applicant meant by "the requester privacy statement describes how each of the requested data-subject data will be used by the requester"

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Flaherty et al. (U.S. Patent Number 6,275,824) hereinafter referred as O'Flaherty.

O'Flaherty teaches the invention as claimed including a method for managing data privacy in a database management system. Storing and retrieving data from a plurality of database tables wherein the data in the database tables is controllably accessible according to privacy parameters stored in the database table (See abstract).

As to claim 1, O'Flaherty teaches A system to enforce privacy preferences on exchanges of personal data of a data-subject, the system comprising of one or more computers connected to one or more networks through one or more

network interfaces, each computer having one or more memories and one or more central processing units (CPUs), the system further comprising:

one or more data-subject authorization rule sets stored in the one or more memories that has one or more subject constraints on release of one or more data-subject data (abstract) ;

a receiving process, executing on the one or more CPUs, that receives a request message from a requester over the network interfaces, the request message having one or more requests for one or more of the data-subject data releases pertaining to a subject, and a requester privacy statement for each of the respective data-subject data requested, (abstract, Column 4, lines 30-Column 5, lines 63); and

a release process executing on the one or more CPUs that compares the requester privacy statement to the subject constraints and releases the data-subject data in a response message to the requester only if the subject constraints are satisfied (abstract, Column 4, lines 30-Column 5, lines 63).

As to claim 2, O'Flaherty teaches a system, as in claim 1, where the requester also has to be authorized to receive the private data (Column 4, lines 49-Column 5, lines 16).

As to claim 3, O'Flaherty teaches a system, as in claim 2, where there is more than one level of authorization (Column 4, lines 49-Column 5, lines 16).

As to claim 4, O'Flaherty teaches a system, as in claim 1, wherein each of the subject constraints further comprises:

an authorization dataset describing the data to which the constraint applies (Column 1, lines 28-Column 2, lines 20; Column 2, lines 57-Column 3, lines 21);

a privacy preference rule that describes the privacy preferences under which the data may be released and the corresponding actions allowed (Column 1, lines 28-Column 2, lines 20; Column 2, lines 57-Column 3, lines 21);

an access list describing who is allowed to access the data (Column 1, lines 28-Column 2, lines 20; Column 2, lines 57-Column 3, lines 21); and

an authorization action that describes any additional action to be taken if the restrictions imposed by the authorization dataset, the privacy preference rule and the access list of this constraint are matched (Column 1, lines 28-Column 2, lines 20; Column 2, lines 57-Column 3, lines 21).

As to claim 5, O'Flaherty teaches a system, as in claim 1, wherein the private, subject data release further comprises:

one or more subject data that is owned and held by the data-subject (Column 2, lines 57-Column 3, lines 21);

one or more subject data that is owned by the data-subject, but held by one or more parties on behalf of the data subject (Column 2, lines 57-Column 3, lines 21); and

one or more subject data that is owned and held by one or more third parties (Column 2, lines 57-Column 3, lines 21).

As to claim 6, O'Flaherty teaches a system, as in claim 1, where one or more of the requesters have to satisfy different subject rule sets for the same private data (Column 4, lines 30-Column 5, lines 63).

As to claim 7, O'Flaherty teaches a system, as in claim 1, where the private, subject data release is partitioned into a first part that satisfies the constraints and is released and a second part that does not satisfy the constraints and is not released (Column 4, lines 30-Column 5, lines 63).

As to claim 8, O'Flaherty teaches a system, as in claim 1, wherein the private, subject data released further comprises one or more data for which additional manual authorization from the subject is needed before the data is released (Column 4, lines 30-Column 5, lines 63).

As to claim 9, O'Flaherty teaches a system, as in claim 1, wherein the private, subject data released further comprises one or more missing values which have to be acquired from the subject before the data is released (Column 4, lines 30-Column 5, lines 63).

As to claim 10, O'Flaherty teaches a system, as in claim 1, wherein private, subject data released further comprises one or more data that is stored with one or more third parties and has to be retrieved from the third parties before the private, subject data release can be released (Column 5, lines 64-Column 6, lines 12).

As to claim 11, O'Flaherty teaches a system, as in claim 1, wherein the private, subject data released further comprises one or ore data that is stored

with one or more third parties and the third parties have to be provided with authorization to release the data to the requester (Column 5, lines 64-Column 6, lines 12).

As to claim 12, O'Flaherty teaches a system, as in claim 1, where the private, subject data release to which each constraint applies comprises one or more of the following:

one or more classes of data, one or more properties of data, and one or more instances of data (abstract).

As to claim 13, O'Flaherty teaches a system, as in claim 1, where the private, subject data release is ordered in a hierarchy with one or more levels and each of the levels has one or more constraints that apply to the respective private, subject data release in the level (abstract, Column 2, lines 57-Column 3, lines 21).

As to claim 14, O'Flaherty teaches a system, as in claim 13, where one or more of the levels have different constraints (abstract, Column 4, lines 30-Column 5, lines 63).

As to claim 15, O'Flaherty teaches a system, as in claim 13, where one or more of the levels inherits one or more of the constraints from one or more other levels (abstract, Column 4, lines 30-Column 5, lines 63).

As to claim 16, O'Flaherty teaches a system, as in claim 13, where the level to which each constraint applies further comprises one or more of the following:

one or more classes of data, one or more properties of data, and one or more instances of data (abstract, Column 4, lines 30-Column 5, lines 63).

As to claim 17, O'Flaherty teaches a system, as in claim 1, where the constraints include privacy preferences based on any one or more of the Platform for Privacy Preferences (P3P) standard privacy statements, including a purpose, a retention, a recipient and an access (abstract, Column 4, lines 30-Column 5, lines 63).

As to claim 18, O'Flaherty teaches a system, as in claim 1, where the data includes any one or more of the following:

a privacy data, a privacy data associated with a natural person, a confidential information, and a trade secret (abstract, Column 1, lines 28-Column 2, lines 20).

Claims 19-37 do not teach or define any new limitations other than above claims 1-18. Therefore, rejected for similar reasons.

7. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

Response to Arguments

8. Applicant's arguments have been fully considered but they are not persuasive.

In the remarks applicant argues in substance that; A) O'Flaherty does not teach a requester privacy statement describes how each of the requested data-subject data will be used by the requester.

In response to A) The newly added limitation is not supported by the applicant's specification. Therefore, the examiner is not consider it at this time.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faruk Hamza whose telephone number is 571-272-7969. The examiner can normally be reached on Monday through Friday.

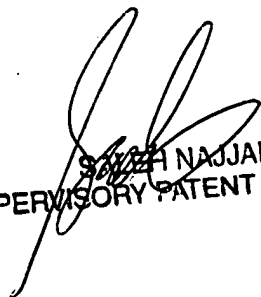
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll -free).

Faruk Hamza

Patent Examiner

Group Art Unite 2155


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER